FILE COPY

Office-Supreme Court, U.S.
FILED
FEB 12 1960
JAMES R. BROWNING, Clerk

No. 622

In the Supreme Court of the United States

OCTOBER TERM, 1959

DON H. RUBENFIELD, PETITIONER

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

J. LEE RANKIN,
Solicitor General,
GEORGE COCHRAN DOUB,
Assistant Attorney General,
SAMUEL D. SLADE,
WILLIAM H. MULLIN,
Attorneys,
Department of Justice, Washington 25, D.C.

INDEX

	Page
Opinion below	1
Jurisdiction	1
Question presented	2
Statutes and rules involved	2
Statement	2
Argument	4
Conclusion	14
Appendix	15

CITATIONS

Cases:

A. B. Dick Co. v. *Underwood Typewriter Co.*, 246 Fed. 309, affirmed, 252 Fed. 990	6
Ajello v. *Pan-American Airways Corp.*, 128 Fed. 2d 196	6
Allen v. *Radio Corp. of America*, 47 F. Supp. 244	9
Ex parte Cady, 1916 C.D. 57, 232 O.G. 619	10
Carson v. *Anaconda Copper Mining Co.*, 26 F. 2d 651, certiorari denied, 278 U.S. 635	9
Ducci v. *Commissioner of Patents*, No. 603, Oct. Term, 1955	2
Gorham Company v. *White*, 14 Wall 511	9, 11
Grier v. *Wilt*, 120 U.S. 412	6
Hazeltine Research v. *General Motors Corp.*, 171 F. 2d 680	9
Hogg v. *Emerson*, 6 How. 437	5
Ex parte Kahn, 1905 C.D. 212, 116 O.G. 2008	11
Leonard v. *Horton*, 40 App. D.C. 22	9
Matheson v. *Campbell*, 78 Fed. 910, 24 C.C.A. 384	7

Cases—Continued

	Page
Parke-Davis & Co. v. *H. K. Mulford Co.*, 189 Fed. 95, affirmed, 196 Fed. 496	6, 7
Pelouze Scale & Mfg. Co. v. *American Cutlery Co.*, 102 Fed. 916	9
Permo Inc. v. *Hudson-Ross, Inc.*, 179 F. 2d 386	9
Ex parte Hill & Renner, 1898 C.D. 38, 82 O.G. 1988	11
In re Schraubstadter, 26 App. D.C. 331	9
Suczek v. *General Motors Corp.*, 132 F. 2d 371	9
Tatincloux v. *Commissioner of Patents*, No. 603, Oct. Term, 1955	2
Thompson v. *Dicke*, 110 F. 2d 98, 27 C.C.P.A. (Patents) 931	9
United States ex rel. Steinmetz v. *Allen*, 192 U.S. 543	4, 6, 7
Western Electric Manufacturing Co. v. *Ansonia Brass & Copper Co.*, 114 U.S. 447	6
Ex parte Wiessner, 1898 C.D. 236, 85 OG. 937	8, 11
Wyeth v. *Stone*, 1 Storey 273	6
Ex parte Yale, 1869 C.D. 110	5

Statutes:

Patent Act of 1842, 5 Stat. 543	8
Patent Act of May 1902, 32 Stat. 193	9
R.S. 4888	12
35 U.S.C. 41	7, 13, 15
35 U.S.C. 101	5, 6, 8, 15
35 U.S.C. 111	12, 15
35 U.S.C. 112	11, 12, 16
35 U.S.C. 113	9, 16
35 U.S.C. 120	13
35 U.S.C. 121	13, 16
35 U.S.C. 171	8, 11, 16

Miscellaneous: Page

H. Rept. No. 1923, 82d Cong., 2d Sess., p. 7 ... 12
38 J.P.O.S. ((1956) 301–302 ... 10
Patent Office Rules of Practice, 37 C.F.R. 1.1, *et seq.*:
Rule 75 (37 C.F.R. 1.75) ... 7, 17
Rule 81 (37 C.F.R. 1.81) ... 9
Rules 116–127 (37 C.F.R. 1.116–1.127) ... 14
Rule 151 (37 C.F.R. 1.151) ... 17
Rule 152 (37 C.F.R. 1.152) ... 17
Rule 153 (37 C.F.R. 1.153) ... 3, 4, 10, 11, 17
S. Rept. No. 1979, 82d Cong., 2d Sess., p. 6 ... 12
Seidman and Horwitz, *Patent Office Rules and Practice* (1959), § 141.2 ... 5–6

In the Supreme Court of the United States

OCTOBER TERM, 1959

No. 622

DON H. RUBENFIELD, PETITIONER

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The opinion of the United States Court of Customs and Patent Appeals (Pet. App. 15–24) is reported at 270 F. 2d 391.

JURISDICTION

The judgment of the United States Court of Customs and Patent Appeals was entered on May 22, 1959. A timely motion for rehearing was denied on October 6, 1959 (Pet. 1). The petition for a writ of certiorari was filed on December 31, 1959. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.[1]

[1] We have previously argued to the Court that it does not have jurisdiction to review a decision of the Court of Customs and Patent Appeals affirming a refusal of the Board of Appeals

QUESTION PRESENTED

Whether Patent Office Rule 153, which requires that an application for a design patent contain only one claim, is invalid.[2]

STATUTES AND RULES INVOLVED

The pertinent provisions of Title 35, United States Code, and the Patent Office Rules of Practice, 37 C.F.R. 1.1, *et seq.*, are set out in the Appendix, *infra*, pp. 15–17.

STATEMENT

Petitioner, on October 29, 1954, applied for a patent on a design for a floor waxer (R. 3–9). The application contained three claims for patents, and drawings showing eight figures (R. 7–9). The first claim was for a patent on "The ornamental design for a Floor Waxer substantially as shown in Figures 1 to 4 inclusive", while the second claim was for "The ornamental design for a Floor Waxer substantially as shown in Figures 5 to 8 inclusive" (R. 20). The only difference between the floor waxer shown in figures 1 through 4, and that depicted in figures 5 through 8, was that the latter had two braces, apparently supporting the handle, while the former did not. (R. 7–9, Pet. App. 19.) The third claim in petitioner's application sought a patent on "The ornamental design for a Floor Waxer having the common appear-

---

of the Patent Office to grant a patent. See, *e.g.*, the brief for the respondent in opposition, *Ducci* v. *Commissioner of Patents*, No. 603, Oct. Term, 1955, pp. 4–7; and the brief for the respondent in opposition in *Tatincloux* v. *Commissioner of Patents*, No. 734, Oct. Term, 1955. We renew and reserve that jurisdictional contention in this case.

[2] See footnote 1, *supra*, p. 1.

ance substantially as shown in Figures 1 to 8, inclusive" (R. 20). The Patent Office Examiner rejected the application on the ground that it presented a multiplicity of claims for patents, in violation of Patent Office Rule 153 (37 C.F.R. 1.53, *infra*, p. 17) (R. 11). This rejection was sustained by the Supervisory Examiner (R. 13–16), and petitioner took an appeal to the Patent Office Board of Appeals, which affirmed the Examiner's decision (R. 19–24).

Petitioner next sought review in the United States Court of Customs and Patent Appeals (R. 25–27). That court affirmed the Board's decision, on the ground that petitioner's application was defective in that it contained more than one patent claim, in violation of Patent Office Rule 153, *infra*, p. 17. (Pet. App. 22–24.) The court's opinion (Pet. App. 15–24), filed on May 22, 1959, makes it clear that the multiplicity of claims in petitioner's application was the sole ground for approving its rejection. The court expressed its sharp disapproval of the Board's alternative ruling that an application for a design patent must always be rejected if its drawings show two or more different articles embodying a single design for which a single patent is sought (Pet. App. 16–21). The court stressed that the concept of a design for patent purposes "is not limited to the exact article which happens to be selected for illustration in an application." In view of the fact that a patentable design is not limited to one article embodying it, the court reasoned, an applicant should be permitted to submit drawings of more than one article

in order to "teach the manner of applying [his design] to different articles * * * [in order to] disclose all that he is entitled to * * * that others may be warned of the probable scope of [his] invention" (Pet. App. 18). The court concluded that "it cannot be stated as an invariable rule that a design application cannot disclose more than one embodiment of the design" (Pet. App. 21), and rejected any such rule.

However, the court rejected petitioner's contention that Patent Office Rule 153, providing that "more than one claim is not permitted", is in conflict with the applicable statutes and therefore invalid, and sustained the Board's decision on the ground of multiplicity of claims (Pet. App. 22). The court's ruling was based on its holding that "The fact that it may be permissible, in a proper case, to illustrate more than one embodiment of a design invention does not require or justify more than one claim. Such embodiments can be presented only if they involve a single inventive concept; and such a concept can be protected by a single claim" (Pet. App. 23).

ARGUMENT

Examination of the Patent Office practice respecting multiplicity of claims shows that Rule 153, prohibiting applicants for design patents from using more than one claim in an application, is entirely reasonable. Moreover, contrary to petitioner's assertions, Congress did not intend to disturb this practice when it enacted Title 35 in 1952, and the decision below is not in conflict with *United States ex rel. Steinmetz* v. *Allen*, 192 U.S. 543. Nor is the case of any

general importance, especially since the decision below, in correcting the Patent Office practice of permitting a design applicant to show only one embodiment of his design in his drawings, insures full protection to the rights of design applicants.

1. Under Section 101 of Title 35 of the United States Code, enacted in 1952, the Patent Office is directed to issue an invention patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof * * *." Early in its administration of the forerunners of this provision, the Patent Office required that a single application for an invention patent contain in its specification claims for only one invention. The reasons for this requirement were that it increased the amount collected in application fees (*Hogg* v. *Emerson*, 6 How. 437, 483), avoided the inequity of permitting an inventor to obtain more than one patent after paying only one application fee (*Ex parte Yale*, 1869 C.D. 110), and, most importantly, facilitated the administrative processing of patent applications (*ibid.*).[1] The courts, in order to promote clarity and

[1] See also footnote 1, *supra*, p. 1.

[2] See Seidman and Horwitz, *Patent Office Rules and Practice* (1959), § 141.2, pp. 521–522, in which it is stated that a vital reason for the requirement that only one invention be stated in one application, except where the inventions are dependent and related, is to be found in "* * * the classification of the various subjects of invention, and the assignment of the different classes to different Examiners. This division of labor is absolutely essential to the prompt and thorough examination of applications. It is adopted to facilitate the transaction of the public business, and the inventor himself is directly and imme-

certainty in patents and applications, early declared this requirement to be consistent with the former version of 35 U.S.C. 101.[5] See, *e.g.*, *United States ex rel. Steinmetz* v. *Allen*, 192 U.S. 543, 557–558; *Wyeth* v. *Stone*, 1 Storey 273.

However, it was also recognized that the validity of an invention patent, and the scope of the monopoly granted under it, must be determined solely by what the inventor claimed in his application. See, *e.g.*, *Western Electric Manufacturing Co.* v. *Ansonia Brass & Copper Co.*, 114 U.S. 447; *Grier* v. *Wilt*, 120 U.S. 412; *Ajello* v. *Pan-American Airways Corp.* 128 F. 2d 196 (C.A. 2). It therefore became the practice that an applicant was permitted to include several claims, each one expressing what he intended to patent in language different from the others, so that he could be sure to cover, in at least one claim, all the patentable elements of his invention, without using language so broad that his patent would be invalid for covering unpatentable elements. See, *e.g.*, *A. B. Dick Co.* v. *Underwood Typewriter Co.*, 246 Fed. 309 (S.D.N.Y.), affirmed, 252 Fed. 990 (C.A. 2); *Parke-Davis & Co.* v. *H. K. Mulford Co.*, 189 Fed. 95 (S.D.N.Y.), affirmed, 196 Fed. 496 (C.A. 2).

---

diately benefited by a strict adherence to it. Any union of inventions in one patent that would seriously impair this classification ought not to be permitted. Besides the delay and increased difficulty in making the examination, if the patent covers devices which enter into two classes, the drawing, which is single, must be deposited in the portfolio of the one class and be wanting in the portfolio of the other. It may thus be overlooked in the examination, of the next case."

[5] In the *Parke-Davis* case, Judge Learned Hand, then a district judge, said, 189 Fed. at 102–103: "* * * the only valid

The desirability of allowing multiple claims in applications for inventions is recognized in Patent Office Rule 75, which declares that, in invention patents, more than one claim may be presented, provided they differ substantially from one another and are not unduly multiplied, 37 C.F.R. 1.75. In recognition of the extra administrative work required when multiple claims are presented in an application, 35 U.S.C. 41 specifies that, except for design cases, the application fee should be $30 and $1 for each claim in excess of twenty.[6]

---

objection to multiplication of claims is when it appears that the patentee is trying deceitfully to go beyond the fair scope of his invention. * * * No one can in advance know how far anticipations will go or how little in the end his patent will cover. There is nothing improper, so far as I can see, in first putting your claims as broadly as in good faith you can, and then, ex abundanti cautela, following them successively with narrower claims designed to protect you against possible anticipations of which you are not yet aware. Indeed, the very case upon which the defendant relies (*Matheson* v. *Campbell*, 78 Fed. 910, 917, 24 C.C.A. 384) shows the necessity of claims as broad as one can honestly support. If any one of the specified differentia of the claim is missing, the defendant's product does not infringe; if any anticipation includes all the differentia, the claim is bad. To pass between this Scylla and Charybdis, I think a patentee may fairly be entitled to bend sails upon many yards."

[6] In addition to the rule that an inventor may, when necessary for his full protection, express his single invention in more than one claim, an exception developed to the general rule that only one patent may be applied for in one application. In *United States ex rel. Steinmetz* v. *Allen*, 192 U.S. 543, it was held that, notwithstanding the general rule, inventions which are related may be joined in one application. *Steinmetz* involved an attempt to obtain separate patents on a process for measuring electric current and the apparatus, or meter, for putting the process into operation. Then Patent Office Rule 41 provided, *inter alia*, that "Claims for a machine and the process in the

2. As we have just shown, *supra*, pp. 5–7, an applicant for an *invention* patent is usually permitted to use several claims to express what he seeks to patent. The practice is quite different in *design* cases. Since 1898 the Commissioner of Patents has required design patent applicants to include only one claim in each application. *Ex parte Wiessner*, 1898 C.D. 236, 85 O.G. 937. The reason for this difference in practice is easily seen in the distinctions between invention and design patents.

An invention patent is granted for a "new and useful" process, machine, manufacture, or composition of matter, or an improvement thereof. 35 U.S.C. 101, *supra*, p. 5. Words are the best means of explaining what constitutes the novelty or originality in such an article or process, and it is not surprising that the words of a claim for an invention are determinative of its scope and validity. However, in an application for a patent on a "new, original and ornamental design for an article of manufacture" (the statutory definition of a patentable design, 35 U.S.C. 171),[7] one

---

performance of which the machine is used must be presented in separate applications." This Court held, however, that claims for related inventions may be joined in one application. The Court recognized that the determination of whether two inventions are related should normally be left to the discretion of the Commissioner of Patents. Since the invention of a machine and its process are at least sometimes related, the Court held that the Commissioner could not refuse to exercise his discretion by providing by rule that a machine and its process may not be joined in one application.

[7] The Patent Act of 1842, 5 Stat. 543, the original provision for design patents, declared that patents should be awarded on "new and original" designs. The provision that the design

picture is worth a thousand words. For it is the visual impression conveyed by a design which determines questions of patentability and of infringement. See *Gorham Company* v. *White*, 14 Wall. 511, 525–527; *Pelouze Scale & Mfg. Co.* v. *American Cutlery Co.*, 102 Fed. 916, 918; *In re Schraubstadter*, 26 App. D.C. 331.

Since it is the effect on the eye, rather than the language describing this effect, which is all-important in design patents, Patent Office Rule 152 requires that all applications for design patents include drawings, while drawings are required in invention applications only "whenever the nature of the case admits" (Patent Office Rule 81, 37 C.F.R. 1.81; see 35 U.S.C. 113).[8] Additionally, because verbal descriptions of the design would probably confuse readers as to what the design actually is—the most expertly written verbal description of a design would give no two people the same idea of the visual sensation conveyed by the design—the Patent Office normally permits no description in the specification of a design patent

---

must also be "ornamental" was added by the Patent Act of May 1902, 32 Stat. 193.

[8] Where a drawing is included in an application for an invention patent, it has uniformly been held that the words of the claim, not the drawing, govern the validity and scope of the patent. See, *e.g.*, *Permo Inc.* v. *Hudson-Ross, Inc.*, 179 F. 2d 386 (C.A. 7); *Hazeltine Research* v. *General Motors Corp.*, 171 F. 2d 680 (C.A. 6); *Allen* v. *Radio Corp. of America*, 47 F. Supp. 244 (D. Del.); *Leonard* v. *Horton*, 40 App. D.C. 22; *Carson* v. *Anaconda Copper Mining Co.*, 26 F. 2d 651 (C.A. 9), certiorari denied, 278 U.S. 635; *Thompson* v. *Dicke*, 110 F. 2d 98, 27 C.C.P.A. (Patents) 931; *Suczek* v. *General Motors Corp.*, 132 F. 2d 371 (C.A. 6).

application, Patent Office Rule 153, 37 C.F.R. 1.153.[9] The Rules also set out that, ordinarily, the claim in a design application should merely state the name of the article for which the design is intended, and refer to the drawings where the design is depicted. A typical example, then, of a design claim in the correct form is that which the Court of Customs and Patent Appeals suggested as proper for the petitioner's design: simply a claim for "The ornamental design for a floor waxer substantially as shown" (Pet. App. 23).

Since the function of the claim in the design patent is merely to refer the reader to the drawings, the necessity of permitting an inventor to express his invention in more than one claim, recognized in invention patents where the words of the claims are all important, does not exist in design patent cases.[10] This is especially true now that the Court of Customs and Patent Appeals has in this very case corrected the practice, followed from time to time by the Com-

[9] In *Ex parte Cady*, 1916 C.D. 57, 232 O.G. 619, the Commissioner of Patents succinctly stated:

"As to the appearance of the design, it is improper to describe that, because no amount of language can explain how a thing looks as well as the thing itself explains how it looks."

[10] In addition to serving no useful purpose, permitting the inclusion of more than one claim would be extremely detrimental to the administration of the Patent Office. A memorandum from the Patent Office Committee on Practice and Procedure to the Commissioner of Patents, referred to at 38 J.P.O.S. (1956) 301–302, states that a proposed revision of Patent Office Rule 153 to allow multiple claims in design patents would inevitably make the examiner's job more time-consuming and thus require more personnel for the processing of design claims. See also note 4, *supra*, p. 5.

missioner of Patents,[11] of not allowing the design applicant to show more than one embodiment of his design in his drawings. The design applicant is now permitted "to bend sails upon many yards", see note 5, *supra*, p. 6, by submitting drawings showing all the articles in which he believes his design can be embodied.[12]

3. Petitioner contends that, nevertheless, Patent Office Rule 153 was rendered invalid by the enactment in 1952 of Section 171 of Title 35, governing design patents, *supra*, p. 8, which, like the original design patent statute, directs that the provisions relating to invention patents should apply to design patents, except as otherwise provided. Thus, Section 112 of Title 35, dealing with the contents of invention patent appli-

[11] See *e.g.*, *Ex parte Kahn*, 1905 C.D. 212, 116 O.G. 2008; *Ex parte Hill & Renner*, 1898 C.D. 38, 82 O.G. 1988.

[12] It also should be noted that a design applicant may not submit more than one design in one application, by use of multiple claims. As we noted above, *supra*, p. 7, the general rule for invention patents is that only one patent may be applied for in one application, but an exception is recognized in the case of related inventions. This exception, however, does not apply to design patents because two designs can never be related or dependent on each other. By its very nature, a design is an independent unit, deriving its identity and its patentability from the overall impression it creates on the eye of the observer, see p. 9, *supra*. If two articles create separate and distinct impressions on the eye of the beholder, each has its own design. If they create the same impression, they have, under the rule of *Gorham Company* v. *White*, 14 Wall. 511, *supra*, the same design. Therefore, the Patent Office has, since 1898, taken the position that relationship, for purposes of joinder of claims, does not exist in design cases. *Ex parte Wiessner*, 1898 C.D. 236, 85 O.G. 937. Contrary to petitioner's assertion (Pet. 8), there is no relationship of genus and species for design patents.

cations, is made applicable to design patent applications. The former version of Section 112, R.S. 4888, provided that the applicant should "particularly point out and distinctly claim" his invention, but in 1952 the statutory language was changed to read "[t]he specification shall conclude with one or more claims * * *." Petitioner seizes on this language and reads it to require, in all cases, including design patent cases, that multiplicity of claims be allowed. However, the words "one or more" cannot be construed to vest in all patent applicants a right to more than one claim in an application. In any event, there is no indication in the legislative history of Title 35 that Congress, in making this change in language, intended to do anything more than codify the Patent Office's existing practice of allowing only one patent to be claimed in one application, except in the case of related inventions, and of allowing multiplication of claims for one invention only where necessary in invention applications to permit the applicant to make sure that at least one of his claims expresses all of his invention without including too much.[13]

[13] The Reports of the Senate and House Committees which reported bills resulting in the enactment of Title 35 dwell at length on changes in statutory language in other sections in which changes in practice were intended, but each report passes over Sections 111 and 112, with the identical sentence: "The next group of sections relates to the application for a patent." S. Rept. No. 1979, 82d Cong., 2d Sess., p. 6; H. Rept. No. 1923, 82d Cong., 2d Sess., p. 7. The reviser's note following Section 112 states in part:

"The clause relating to the claim is made a separate paragraph to emphasize the distinction between the description and the claim or definition, and the language is modified."

It also should be pointed out that Congress did not change the statutory scheme of fixing fees in design cases solely on

Petitioner also contends that the decision below is incorrect because of 35 U.S. 121, providing that "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." Section 121 goes on to provide that if the invention required to be taken out of the application is applied for in a "divisional-application" under Section 120, it will receive the benefit of the original application, and neither invention may be used as a reference against the validity of the other in the Patent Office or the courts. Petitioner's argument is that the decision below deprives design applicants of a "substantial legal right" to have the Commissioner of Patents require division of applications (Pet. 7). Further, he contends, it deprives the Patent Office of the "authority and means of orderly procedure" of requiring division in design cases (Pet. 8). But there is nothing in the decision implying that, if it appears to the Commissioner that an applicant's drawings show two separate and distinct designs, he may not require that the drawings showing one of the designs be omitted from the application and filed separately. There is likewise no intimation in the opinion that the second application, if Section 120 is complied with, will not receive the statutory protection afforded in Section 121. Petitioner gratuitously states that the only "units of invention" which can be so separated by the Commissioner are claims (Pet. 10),

---

the basis of the length of time of the monopoly claimed, while in invention cases, the fee is based in part on the number of claims. See 35 U.S.C. 41(a)(1), (2), (3).

but cites no authority or practice for such an arbitrary limitation on the Commissioner's power and on the rights of applicants.

4. Finally, it should be said that the case is of no general importance. As the court below noted (Pet. App. 23), the petitioner can receive full protection for his design simply by stating his claim as follows: "The ornamental design for a floor waxer substantially as shown."[11] Now that the Court of Customs and Patent Appeals has corrected the practice of limiting the design patent applicant to a showing of only one embodiment of his design, applicants may show as many things as they believe can embody their design. No greater protection would be added by allowing multiplication of claims.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted,

J. LEE RANKIN,
Solicitor General.
GEORGE COCHRAN DOUB,
Assistant Attorney General.
SAMUEL D. SLADE,
WILLIAM E. MULLIN,
Attorneys.

FEBRUARY 1960.

[11] So far as the record discloses, the petitioner has made no attempt to amend his application in the form suggested by the court. Amendments are permitted under Patent Office Rules 116–127, 37 C.F.R. 1.116–1.127.

APPENDIX

Statutes and Rules Involved

1. Title 35, United States Code, provides in pertinent part:

§ 41. *Patent fees*

(a) The Commissioner shall charge the following fees:

1. On filing each application for an original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

2. On issuing each original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

3. In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

* * * * *

§ 101. *Inventions patentable*

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 111. *Application for patent*

Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

§ 112. *Specification*

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

§ 113. *Drawings*

When the nature of the case admits, the applicant shall furnish a drawing.

* * * * *

§ 121. *Divisional applications*

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title, it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

* * * * *

§ 171. *Patents for designs*

Whoever invents any new, original and ornamental design for an article of manufacture

may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

2. The pertinent provisions of the Patent Office Rules of Practice, 37 C.F.R. 1.1, *et seq.*, are as follows:

Rule 75 (37 C.F.R. 1.75)
Claim

* * * * *

(b) More than one claim may be presented: Provided they differ substantially from each other and are not unduly multiplied.

* * * * *

Rule 151 (37 C.F.R. 1.151)
Rules applicable

The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.

Rule 152 (37 C.F.R. 1.152)
Drawing

The design must be represented by a drawing made in conformity with the rules laid down for drawings of mechanical inventions and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the article.

Rule 153 (37 C.F.R. 1.153)
Title, description and claim

The title of the design must designate the particular article. No specific description, other than a reference to the drawing, is ordinarily required or permitted. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

* * * * *

U.S. GOVERNMENT PRINTING OFFICE: 1960